

## REMARKS

This application was filed with a claim of foreign priority under 35 U.S.C. §119(a)-(d) based on the following Japanese Patent Applications: 2002-334236 filed November 18, 2002; 2002-334238 filed November 18, 2002; 2002-334240 filed November 18, 2002; and 2003-068370 filed March 13, 2003. Certified copies of the priority documents filed on January 30, 2006. Acknowledgment of the claim of foreign priority is again respectfully requested, and acknowledgment of receipt of the priority documents is now requested.

Claims 1 to 36 remain in the application. Claims 7 to 36 stand withdrawn as being drawn to a non-elected invention/species. In the amendment filed January 25, 2006, the Examiner was requested to clarify the restriction requirement as to the election of species of the Group I, claims 1-33. This request was set out in considerable detail on pages 9 to 11 of the January 25<sup>th</sup> amendment and is incorporated herein by reference. In this most recent Office Action, the Examiner has failed to acknowledge this request. In a telephone interview with Examiner Tran on April 12, 2006, concerning this request, Examiner Tran first said that she did not consider the request since the election was made without traverse. The undersigned asked whether the election of species requirement should now be traversed in order to obtain the clarification requested. In response, Examiner Tran said that she would review the request as set out on pages 9 to 11 of the January 25<sup>th</sup> amendment and respond in the next Office Action.

Briefly stated, Applicants asked for clarification of the requirement for election of species since the Examiner identified the species only by grouping of claims with no reference to the drawing figures. Therefore, it is not entirely clear what the Examiner considers to be the patentably distinct species. It is noted that Group I claims have only one independent claim, specifically claim 1. It is further noted that claims 2, 7, 14, and 26 are directly dependent on claim 1. Clearly, claim 1 must be considered a generic claim as it is common to all the species identified by the Examiner. Further, should claim 1 be found allowable, then all of Group I claims should be allowable. If this understanding is not correct, the Examiner is requested to explain why this is not so.

It was pointed out in the amendment filed January 25, 2006, that only one species of surface treatment apparatus (Group I claims) is disclosed, although several species of image recording apparatus (Group II claims) are disclosed. Applicants therefore again request that the Examiner clarify her requirement for election of species and, if clarification of the election of species requirement can not be provided, the Examiner is requested to withdraw her requirement for election of species and examine all the Group I claims on their merits.

Claims 1 and 5 have been amended herein.

Claims 1 to 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. EP 1 407 893 A2 to Janosky et al. in view of newly cited U.S. Patent No. 6,332,679 to Higuma et al. This rejection is respectfully traversed for the reason that the combination of Janosky et al. and Higuma et al. does not suggest or otherwise teach the claimed invention.

This rejection replaces the rejection made in the Office Action mailed November 2, 2005, in which claims 1 to 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Janosky et al. European Patent Application in view of U.S. Patent No. 5,764,262 to Wu et al. In the most recent Office Action, the Examiner makes no mention of this prior rejection. It is assumed that since she has not repeated the prior rejection, she has withdrawn that rejection.

In the most recent Office Action, the Examiner responded to remarks concerning the Janosky et al. with the following statement:

“This argument is not deemed to be persuasive because referring to figure 2, after the image is recorded on the sheet 14, the sheet 14 is transported to lamination unit with the heater belt and the driver roller 24, when the sheet 14 is interposed between the heated belt 26 and the roller 24, the outer surface of the belt is transferred onto the sheet 14.”

The foregoing statement suggests that the Examiner either does not understand or has misinterpreted the Janosky et al. reference. First of all, Figure 2 of Janosky et al. is the embosser 22 shown in the general block diagram of Figure 1. The laminator 18 is a separate unit. As shown in Figure 2, the print 14 has a protective clear plastic layer 20 as applied by the laminator 18. The plastic layer 20 is applied over the ink jet printed image on print 14. The endless embossing belt 26 is heated by heater 25 and is trained around drive/idle rollers 28, 30 and 32. The roller 28

functions as a backing roller to create a nip with the heated roller 24. The laminated print 14/20 is fed to the embosser 22 (Figure 2) with its laminated surface 20 oriented toward the textured surface 34 of the embossing belt 26. If a glossy print is desired, the roller 24 is moved by drive 40 so as to increase the spacing between the heated roller and the backing roller 28, allowing the laminated print to pass freely between the two rollers and onto the embossing belt 26. If a matte finish is desired, the drive 40 is operated to decrease the spacing between the heated roller 24 and the backing roller 28 so a nip is formed. The laminated print entering the nip is heated and the laminated surface 20 is pressed by the roller 24 against the textured surface 34 of the embossing belt 26. The applied heat softens the laminate 20 so that the pressure is sufficient to impress the laminated surface 20 with the texture of the embossing belt. There is no transfer of surface quality to the image recording layer as recited in claim 1. There is no transfer of surface quality to an interface of the thermoplastic resin layer facing the image recording layer as recited in claim 1. The processes, and the apparatuses that perform those processes are entirely different. As the Examiner again acknowledged in the Office Action, Janosky et al. fails to disclose a sheet having at least a base, a thermoplastic resin layer, and an image recording layer on the base (see Office Action, page 3).

The Examiner relies on Higuma et al. for a teaching of a sheet having at least a base and a thermoplastic resin layer, citing column 3, lines 40–45, of Higuma et al. What Higuma et al. disclose is an image forming method and image forming apparatus for forming images using a recording section and a nip region for effecting a flattening process after the visible images are formed. The recording medium has a porous layer having thermoplastic resin particles on a surface and includes a base material, a recording layer substantially absorbing and capturing inks and color materials formed on the base material, and a porous layer having a thermoplastic resin layer formed on the recording layer. Higuma et al. are primarily concerned with the “formation of a good *flattened layer* by means of a relatively simplified structure” (emphasis added). See column 1, line 66, to column 2, line 1. This they accomplish by forming visible images on the recording medium and then conveying the recording medium to the nip region comprising

roller 105 and 106. The flattening process is illustrated, for example, in Figure 8. The purpose of this process is flatten the transfer layer to form a color retaining layer after the ink solvent is evaporated so as to eliminate “peeling” while the color materials of the inks are held in the transfer layer.

Quite clearly, there is no teaching in Higuma et al. of any surface treatment other than flattening the transfer layer. There is no reason to suppose that the recording medium of Higuma et al. could be used in the process according to Janosky et al., and the only incentive the Examiner has for the combination is Applicants own teaching. If the recording medium of Higuma et al. were to be used in the Janosky et al. process, there would still be the requirement of applying a clear plastic laminate layer 20 over the recording medium bearing the recorded image before the laminate structure is transported to the embosser 22 (Figure 2 of Janosky et al.). There would still not be “a surface treatment apparatus comprising: a sheet heating unit which heats a sheet having at least a base, a thermoplastic resin layer, and an image recording layer disposed on the base; a contact member for *transferring a surface quality* thereof to a surface of the image recording layer *and an interface of the thermoplastic resin layer facing the image recording layer* of the sheet; and a sheet cooling unit which cools the sheet while in contact with the contact member” (emphasis added), as particularly recited in claim 1.

The proper application of the standard under Section 103 requires that the claimed invention must be considered as a whole, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention, and there must be a reasonable expectation of success as the standard with which obviousness is determined. See MPEP 2141. Here, the Examiner has failed to consider the claimed invention as a whole or the references as a whole. Instead, she has taken a passage out of context from Higuma et al. and combined it for purposes of the rejection with Janosky et al. without regard for the fact that Higuma et al. is totally unrelated to either Janosky et al. or the claimed invention, and the sole basis for her combination of these diverse references has to be impermissible hindsight.

Furthermore, she has not suggested that there would be any reasonable expectation of success. On the contrary, as been suggested above, the proposed combination would, at best, result in nothing more than the Janosky et al. process using a different recording medium. This is not what is being claimed.

Since claim 1 is clearly generic to any all species of the surface treatment apparatus of Group I claims and is patentable for the reasons advanced above or, in the alternative, since the requirement for election of species was in error, it is requested that all of the claims of Group I be considered on their merits and allowed. Therefore, in view of the foregoing, it is respectfully requested that the application be reconsidered, that claims 1 to 33 be allowed, and that the application be passed to issue. On the condition, that claims 1 to 33 are allowed, Applicants authorize the cancellation of claims 34 to 36 by Examiner's Amendment.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'C. Lamont Whitham', with a stylized, flowing script.

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